

REMARKS

The present application was filed on September 26, 2003 with claims 1 through 25. Claims 1, 2, 4-7, 11-14, 16-19 and 23-25 are presently pending in the above-identified patent application.

5 In the Office Action, the Examiner rejected claims 1, 2, 4, 12-14, 16 and 24-25 under 35 U.S.C. §103(a) as being unpatentable over King et al. (United States Patent No. 7,050,017) in view of Gass (United States Publication No. 2004/0123193, rejected 5-7 and 17-19 under 35 U.S.C. §103(a) as being unpatentable over King et al. in view of Gass and further view of Welch (United States Publication No. 2004/0097246), and rejected claims 11 and 23 under 35
10 U.S.C. §103(a) as being unpatentable over King et al. in view of Gass and further view of Schmidt (United States Publication No. 2002/0196029).

Independent Claims 1, 13 and 25

Independent claims 1, 13, and 25 were rejected 35 U.S.C. §103(a) as being unpatentable over King et al. in view of Gass. With regard to claim 1, for example, the
15 Examiner asserts that King et al. teach transmitting a wireless signal from said integrated circuit device to said monitoring station using an antenna associated with said integrated circuit device, wherein said antenna is a pin on said integrated circuit device. (citing col. 1, lines 56-62; col. 3, lines 18-23 and 31-39; col. 5, lines 51-65 and FIG. 1).

Contrary to the Examiner's assertion, however, King et al. do not disclose or
20 suggest "wherein said antenna is a pin on said integrated circuit device." Rather, King et al. expressly teach using an antenna that is *external* from the integrated RFID circuit. In col. 1, lines 52-53 and 61-62, it is expressly stated that at least one pin is an antenna pin for connection to an *external* antenna (conductive belt in tire). In other words, the RFID pin is merely a *connector* to an external antenna. See also, col. 3, line 22.

25 The Examiner acknowledges that King et al. do not teach "monitoring station performs one or more of testing, debugging and evaluating said integrated circuit," but asserts that Gass teaches this feature.

Applicant notes that Gass *teaches away* from wireless communications between an integrated circuit device and a monitoring station that is debugging the integrated circuit. First, Gass does not address any type of communication between an *integrated circuit* device being tested and a monitoring station. Rather, Gass is directed to communications between a host device and a target device. While the host device may be a test/debug device, there is no disclosure that the target device is an integrated circuit. In any event, Gass specifically shows *wired* connections between the between a host device and a target device. See, e.g., FIG. 1.

As stated in the Abstract, Gass teaches an enhanced parallel port JTAG interface (IEEE Test Access Port). The enhanced JTAG *cable* is connectable between an Enhanced Parallel Port (EPP) and a JTAG port and has increased performance over using a Standard Parallel Port (SPP). The use of the JTAG cable by Gass *teaches away* from *wireless* communications between an integrated circuit device and a monitoring station that is debugging the integrated circuit.

KSR Considerations

As indicated above, there is no teaching of the antenna being a pin on the integrated circuit device. Thus, even as combined in the manner suggested by the Examiner, King et al. and Gass *do not teach every element of the independent claims*. Furthermore, based on the KSR considerations discussed hereinafter, the combination/modification suggested by the Examiner is not appropriate. Other than to allege that the improvement of wireless short range operation, the Examiner has failed to establish “an apparent reason to combine ... known elements.” *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. ___, 82 USPQ2d 1385 (2007). Applicant queries how an alleged “improvement of wireless short range operation” suggests wireless communications between an integrated circuit device and a monitoring station that is debugging the integrated circuit. The examiner has not identified any portion of King et al. or Gass that actually teaches “improvement of wireless short range operation” or that would otherwise suggest a combination in the manner suggested by the present invention. The Examiner has not met the burden of proof under *KSR*.

There is no suggestion in King et al. or in Gass, alone or in combination, to employ wireless communications between an integrated circuit device and a monitoring station that is debugging the integrated circuit.

As asserted above, Gass' use of a *hard-wired* cable **teaches away** from the present invention. The *KSR* Court discussed in some detail United States v. Adams, 383 U.S. 39 (1966), stating in part that in that case, "[t]he Court relied upon the corollary principle that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious." (*KSR* Opinion at p. 12). Thus, there is no reason to make the asserted combination/modification.

Thus, a person of ordinary skill in the art would not combine King et al. and Gass in the manner asserted by the Examiner.

Further, Applicant suggests that this *sixth* rejection that fails to establish a *prima facie* case of obviousness is itself evidence of the non-obviousness of the present invention.

Thus, Applicant respectfully requests withdrawal of the Section 103 rejection.

Dependent Claims 2, 4-12 and 14-24

Dependent claims 2, 4-12 and 14-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over various combinations of King et al., Gass, Welch and Schmidt. Claims 2, 4-12 and 14-15 are dependent on claims 1 and 13, respectively, and are therefore patentably distinguished over King et al., Gass, Welch and Schmidt, alone or in any combination, because of their dependency from amended independent claims 1 and 13 for the reasons set forth above, as well as other elements these claims add in combination to their base claim.

All of the pending claims, i.e., claims 1, 2, 4-14, and 16-25, are in condition for allowance and such favorable action is earnestly solicited.

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Examiner is invited to contact the undersigned at the telephone number indicated below.

The Examiner's attention to this matter is appreciated.

Respectfully submitted,

/Kevin M. Mason/

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